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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,216	08/11/2000	Scott J Hultgren	WSHU2005.1	7884

321 7590 11/30/2004

SENNIGER POWERS LEAVITT AND ROEDEL
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS, MO 63102

EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
1631	

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/637,216

Applicant(s)

HULTGREN ET AL.

Examiner

Ardin Marschel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,8,9,13,14,16,17,19 and 136-139 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4,8 and 136-139 is/are allowed.
- 6) ☒ Claim(s) 5,9,16,17 and 19 is/are rejected.
- 7) ☒ Claim(s) 2,5,13,14 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission, filed on 9/7/04, has been entered.

Applicants' arguments, filed 9/7/05, have been fully considered and they are deemed to be persuasive to overcome previous rejections of record. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Unfortunately, upon reconsideration, the following rejections and/or objections are newly applied. They constitute the complete set presently being applied to the instant application.

CLAIM OBJECTIONS

Claims 2, 5, 13, 14, and 19 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Consideration of claim 5 reveals that the compound therein cited comprises SEQ ID NO: 1 or an analog thereof. A reasonable interpretation of said claim 5 is at least one embodiment is directed to SEQ ID NO: 1. Consideration of SEQ ID NO: 1 reveals that it is only seven (7) amino acids in length, in contrast with the minimum length of the

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compounds of claim 1 which at least must contain X_1 through X_{10} or ten (10) amino acid residues. Thus, the seven residue embodiment noted above of claim 5 which depends from claim 1 indirectly contains an embodiment which does not further limit claim 1 from which it depends. Additionally, attempts to fit the seven amino acid residue peptide of SEQ ID NO: 1 of claim 5 into a subsection of instant claim 1 also has failed thus further supporting this objection that claim 5 does not further limit claim 1 from which it depends due to being outside of the scope of claim 1.

Claim 2 is also objected to as not further limiting claim 1 from which it depends since the claim 1 compound embodiments are reasonably all peptide in nature whether the amino acids therein are those naturally occurring or non-natural as, for example, described in the specification on page 18, lines 11-25.

Claim 13 depends from claim 1 but cites X residues that do not further limit the corresponding X residues in claim 1. For example, X_3 of claim 13 may be aliphatic or T whereas X_3 of claim 1 is more limited to being either hydrophobic or a hydroxyl-substituted aliphatic residue. It is noted that the aliphatic option in claim 13 is broader than the hydroxyl...aliphatic residue in claim 1 and also T is listed in the specification on page 16, lines 15-18, as being polar and not hydrophobic or aliphatic. Claim 14 is objected to due to its dependence from claim 14.

Claim 19 is included hereinunder as being objected to due to its dependence from claims 2, 5, and 13 which thus also results in claim 19 containing the objection subject matter.

VAGUENESS AND INDEFINITENESS

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Claims 5, 9, 16, 17, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 cites the phrase "analog thereof" in line 2 therein without any limitation as to what the metes and bounds of such an analog is. It is noted that analogs are discussed in the specification on pages 21-22 but without any description therein as to what is meant by an analog of SEQ ID NO: 1 as in claim 5. Similarly, no definition of the metes and bounds of an analog of SEQ ID NO: 12 regarding claim 9 has been found. Clarification via clearer claim wording is requested.

Claim 16 and claim 17 and 19 via dependence from claim 16 are vague and indefinite due to citing a peptide analog option in line 4 of claim 16 but without any such analog structural limitations in the various components cited in claim 16 thereafter. Clarification is requested as to whether the line 4 citation controls the metes and bounds of claim 16 or its components cited in lines 6 et seq.

INFORMALITIES

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. See, for example, the specification on page 57, lines 22, 24, and 29. Applicants are required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claims 1, 4, 8, and 136-139 are allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices

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published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 26, 2004

Ardin H. Marschel 11/26/04
ARDIN H. MARSCHEL
PRIMARY EXAMINER